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Patent
Attorney's Docket No. 018420-001

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GROUP 2300

In re Patent Application of)

James E. Trownson)

) Group Art Unit: 2306

Serial No.: 07/655,857)

) Examiner: T. Brown

Filed: February 15, 1991)

For: COMPUTER CONTROL SYSTEM)
FOR GENERATING GEOMETRIC)
DESIGNS)

**REQUEST TO RECONSIDER THE
FINALITY OF THE OFFICE ACTION**

Honorable Commissioner of Patents and Trademarks
Washington, D.C. 20231

Sir:

A second Office Action, dated November 5, 1992, has been received in connection with the above-identified application. That Action contained two rejections that were not set forth in the first Office Action. The Action was made final, however, and includes the statement that "Applicant's amendment necessitated the new grounds of rejection." For the reasons discussed below, it is respectfully submitted that the amendments presented by the Applicant did not necessitate the new grounds of rejection. Accordingly, reconsideration and withdrawal of the finality of the Action are respectfully requested.

In the first Office Action, claims 1-6 were rejected under 35 U.S.C. §102 as being anticipated by either of the Daggett et al or Woodman et al patents. In response thereto, Applicant traversed the rejections and pointed out, among other features, that neither of

the Daggett nor Woodman patents disclosed the claimed subject matter of "a single computational resource . . . for receiving feedback information from each of said feedback devices and for controlling the operation of each of said motors to provide coordinated relative movement between the tool and the workpiece along each of said multiple axes". This quoted claim language was present in claim 1 as originally filed, and similar language appeared in independent claim 4.

Claims 7-17, which were also originally filed claims, were not rejected on the basis of prior art.

In the second Office Action dated November 5, 1992, claims 1-4, 7-13 and 15 (as well as newly presented claims 18-23) were rejected under 35 U.S.C. §103 as being unpatentable over either of the Daggett et al or Woodman et al patents in view of the Anderson patent. The rejection states that the Anderson patent is being relied upon because it "discloses the concept of using a single computational resource, a micro-computer numeric control system, to provide a multi-axis motion control system." In response to Applicant's traversal of the rejection of claims 1-6 as being anticipated by either of the Daggett et al or Woodman et al patents, the Office Action states that Applicant's position is overcome by combining those references with the Anderson patent, "who teaches the benefits of controlling using a single-computational resource as compared to multiple processors."

It is respectfully submitted that the citation of the Anderson patent, which was not relied upon in any rejection appearing in the first Office Action, precludes the second Office Action from being made final. There is no showing in the Office Action that any

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of the amendments that were made to claims 1 and 4 necessitated the citation of the Anderson reference. Rather, in the Office Action the Anderson reference is only being relied upon for its alleged disclosure of the use of a single computational resource to provide multi-axis motion control in a numeric control system. As noted above, the concept of a single computational resource was present in claims 1 and 4 as originally filed. While it is true that claim 1 was amended in response to the first Office Action, there has been no showing that the amendments necessitated the citation of the Anderson reference. The subject matter of those amendments is not addressed in the Office Action. Rather, the Anderson reference is only being cited with respect to originally claimed subject matter.

Furthermore, the amendments to claim 4 merely incorporate the subject matter of original claims 5 and 6. These amendments did not introduce any new subject matter for which the Anderson reference was cited. The Anderson reference could have been applied against claims 4, 5 and 6 at the time of the first Office Action. The incorporation of claims 5 and 6 into claim 4 did not necessitate its citation at this time.

Finally, claims 7-13 and 15 were not rejected on the basis of prior art in the first Office Action. The only change that was made to these claims in Applicant's response to the first Office Action was to incorporate the subject matter of dependent claim 14 into independent claim 11. Otherwise, these claims remain in their originally filed form. If

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these claims are properly rejectable as set forth in the second Office Action, there is no showing why the rejections could not have been made in the first Action.


Accordingly, for at least these three reasons, it is respectfully submitted that the finality of the second Office Action is premature. MPEP §706.07(a) states: "Second or any subsequent actions on the merits shall be final, except where the Examiner introduces a new ground of rejection not necessitated by amendment of the application by Applicant, whether or not the prior art is already of record." (emphasis added). This section goes on to state that a second or subsequent Action on the merits "will not be made final if it includes a rejection, on newly cited art, of any claim not amended by applicant . . . in spite of the fact that other claims may have been amended to require newly cited art." There has been no showing in the most recent Office Action that the citation of the Anderson patent was necessitated by any of the amendments made to claim 1, or the incorporation of the subject matter of claims 5 and 6 into claim 4. Nor is there any showing why the Anderson reference could not have been applied against claims 7-17 in the first Office Action.

The reliance upon the Anderson reference and the final rejection precludes the development of a clear issue between the Examiner and the Applicant on the relevance of this new reference to the claimed invention (see MPEP §706.07). Applicant should not be limited to the restrictive requirements of 37 C.F.R. §1.116 in responding to the issues raised by the Anderson patent in the most recent Office Action. It is respectfully requested that the finality of the Office Action be withdrawn, as premature.

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An early decision on this request is earnestly solicited so that Applicant may be apprised of the proper course of action to be followed in responding to the outstanding Office Action.

Respectfully submitted,

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